

REMARKS

Claim 26 is currently pending in the present application. Claims 21, 22, 25 and 27 have been withdrawn from consideration in the advisory action of July 9, 2003. Applicants respectfully request the entry of amendments as indicated in this paper. Claim 26 has been rejected under 35 USC §102(e) in view of Narang et al. (US 5,830,600). The examiner argues that one of ordinary skill in the art would not interpret "optionally" as "necessarily added". However, applicants believe that the amendment to the claim and the remarks below have overcome the examiner's rejection and respectfully solicit the application to issue.

A reference anticipates a claimed invention only if each and every element as set forth in the claim is found either expressly or inherently described in a prior art reference. *Verdegaal Bros. V. Union Oil Co. Of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) (cited at MPEP §2131).

The amended claim now includes the transition phrase "consisting essentially of." According to MPEP §2111.03, this transitional phrase limits the scope of the claim to the specified materials or steps and those that do not materially affect the basic and novel characteristics of the claimed invention. [Citing *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976)]. In light of this interpretation of claim 26, there is no longer strict identity between the presently claimed invention and the reference.

The examiner argues that the CO₂- generating compound of the reference is merely *optional* and thus includes the compositions without the compound. However, Narang discloses that a battery containing a CO₂-generating compounds provides enhanced battery cycling properties. (Column 11, lines 48-50). Specifically, Narang describes that a battery containing a CO₂-generating compound is capable of being charged, discharged and recharged over a greater number of cycles. (Column 11, lines 50-53).

While the abstract discloses that the CO₂- generating compound is optional, the disclosure specifically points out the advantages of the battery containing the

compound. One of ordinary skill in the art would be aware that the performance of storage cells is greatly influenced by the durability of the electrolyte. (See generally, the publications incorporated by reference in applicants specification, page 12, lines 20-21). Specifically, WO 97/16862 (cited in applicants specification) discloses that solvents may evaporate over time or may present fire hazards. (Page 2, lines 17-23). Thus, Narang is ambiguous regarding the necessity of the CO₂-generating compounds because it teaches the advantage of adding the compound to one of ordinary skill in the art.

In view of *In re Hughes*, 345 F.2d 184, 145 USPQ 467, 470 (1965), an ambiguous disclosure may not anticipate the applicants invention. In *Hughes*, the court found that a consideration of *all* phrases in the reference did not describe the appellant's invention. *Hughes* at 471. Accordingly, Narang is ambiguous with respect to the addition of the CO₂- generating compound and therefore cannot anticipate the instant invention.

Furthermore, the Narang reference is encyclopedic in nature with respect to the "fire retardant" solvents and the Lithium salts. The Narang reference provides the opportunity for the selection from a number of different solvents. Narang discloses the preferred salts of LiPF₆, LiAsF₆, LiN(SO₂CF₃)₂ but is silent with respect to the mixture of LiBF₄ with another lithium salt. Furthermore, in all detailed examples Narang uses different solvents in combination with different lithium salts as claimed in the present application. Accordingly, one of ordinary skill in the art would be forced to choose a solvent from the different lithium salt. However, this is not the standard for anticipation by a reference. "[P]icking and choosing" from an encyclopedic disclosure will not ordinarily anticipate, *Air Products and Chemicals, Inc. V. Chas. S. Tanner Co. Et al.*, 219 USPQ 223, 231 (DC SC 1983). Accordingly, the Narang reference cannot anticipate claim 26 of the instant application.

In view of the foregoing amendment and remarks, applicants consider that the rejection of record have been obviated and respectfully solicit passage of the

application to issue.

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Respectfully submitted,

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